



Patent Attorney Docket No.: 109488.135 (ALX-21)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: WANG *et al.*)
)
Serial No.: 09/528,225)
)
Filed: 21 March 2000)
)
For: CHIMERIC PROTEINS)
FOR DIAGNOSIS AND)
TREATMENT OF)
DIABETES)

Examiner: C. Saoud

Art Unit: 1647

RECEIVED

SEP 20 2002

TECH CENTER 1600/2900

Commissioner of Patents
Washington, DC 20231

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

PURSUANT TO 37 C.F.R. § 1.181(a)

Pursuant to 37 C.F.R. § 1.181(a), Applicants hereby petition to withdraw the holding of abandonment of the above-referenced application, which became abandoned for allegedly failing to respond to the Office Action mailed on 06 November 2001.

Applicants respectfully submit that the holding of abandonment is improper as will become evident from the following facts:

1. On 20 November 2001, Mr. Mark Farber of Alexion Pharmaceuticals (Associate Attorney of Record in the above-referenced application) asked his assistant, Ms. Carolynn Wise, to file the Response to the Office Action dated 06 November 2001, which he had prepared the previous day. On the same day, Ms. Wise proceeded to prepare, sign and date a Certificate of First Class Mailing, and placed the Certificate, the Response, and a Return Postcard in an envelope with sufficient first class postage addressed to the Assistant Commissioner of Patents, Washington, DC 20231 (Exhibit A). Ms. Wise then deposited the envelope with the United States Postal Service first class mail on the same day.

2. On 29 May 2002, the undersigned telephoned the Group 1600 receptionist at the U.S. Patent and Trademark Office ("USPTO") to determine the status of the above-referenced application, as no Action on the Merits had been received by the Applicants in over 6 months. The receptionist (Ms. Aster Abdi) stated that an Office Action (Restriction Requirement) had been mailed on 06 November 2001 and that the application was abandoned for failure to respond to that Office Action. She proceeded to pull the file and fax a copy of the 06 November 2001 Office Action to both the undersigned and Mr. Mark Farber that afternoon. See 29 May 2002 Memo to File, Exhibit B.

3. On 10 June 2002, Mr. Farber contacted the undersigned and stated that he had filed a Response to the 06 November 2001 Restriction Requirement on 20 November 2001. Thus, the Application should not be abandoned. See 11 June 2002 Memo to File, Exhibit C.

4. On 11 June 2002, the receptionist at the USPTO was again contacted regarding the status of the application. She stated that an Office Action was mailed on 06 November 2001, but the filed Response was not yet in the system. However, she stated that, contrary to the information provided to the Applicants on 29 May 2002, the application was definitely not abandoned. She stated that the file recently went to USPTO docketing and that the Response was likely just being put in the file because USPTO docketing was "really far behind." She stated that a follow-up phone call should be made in the upcoming weeks to confirm that the Response had been put in the file. See 11 June 2002 Memo to File, Exhibit C.

5. On 18 July 2002, a follow-up telephone call was made to the USPTO receptionist (Ms. Carolyn Dallman) regarding the Response to the Restriction Requirement being placed in the file. She stated that the Restriction Requirement was mailed on 06 November 2001, and the application was abandoned. The undersigned informed Ms. Dallman of the two prior conversations in which Applicants were originally told the application was abandoned (29 May 2002) and then that it was not abandoned (11 June 2002). She stated that it definitely was abandoned and that, according to the computer, the Notice of Abandonment had been sent on 13

June 2002¹. She stated that she would pull the file and telephone the undersigned "in a couple days" when she received the file. See 18 June 2002 Memo to File, Exhibit D.

6. On 19 July 2002, Ms. Dallman telephoned the undersigned and stated that the Response to the Restriction Requirement, which was filed by the Applicants on 20 November 2001, was not in the file. She stated that a copy of the documents submitted by the Applicants on 20 November 2001 should be faxed to her so that she could try to resolve the matter. See 18 June 2002 Memo to File, Exhibit E.

7. On 23 July 2002, the undersigned received from Mr. Farber a copy of the Response and signed Certificate of First Class Mailing, which was dated 20 November 2001 (Exhibit E). The dated Return Postcard, although submitted to the USPTO (as is indicated on the signed Certificate of First Class mailing), was never received by Mr. Farber. The same day, the undersigned telephoned Ms. Dallman, and she stated that without a dated Return Postcard, the application would stand abandoned.

Applicants submit that a Response to the 06 November 2001 Office Action was filed on 20 November 2001, and should be accorded that date pursuant to 37 C.F.R. § 1.8.

37 C.F.R. § 1.8 states the following:

§ 1.8 Certificate of Mailing or Transmission.

- (a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.
 - (1) Correspondence will be considered as being timely filed if:
 - (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
 - (A) Addressed as set out in 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; ... and
 - (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated. ...
 - (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is

¹ This would explain why the file was in USPTO docketing at the time of the 11 June 2002 phone call to the USPTO receptionist. Further, the Notice of Abandonment has not been received by Applicants.

dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission...(Emphasis added).

A copy of the Office Action Response and signed Certificate of First Class Mailing (dated 20 November 2001) are submitted herewith as Exhibit A. Applicants submit that the Certificate of First Class Mailing meets all the requirements of 37 C.F.R. § 1.8 (a).

Ms. Carolynn Wise is no longer an employee of Alexion Pharmaceuticals, Inc., and attempts to reach Ms. Wise have been unsuccessful. Nevertheless, the Certificate of First Class Mailing evidences the timely filing of the Response on 20 November 2001.

Applicants are promptly submitting this Petition within two months of discovering the holding of abandonment on 18 July 2002.

Thus, Applicants submit that all the requirements of 37 C.F.R. § 1.8 are fulfilled, and the holding of abandonment is improper.

Applicants also respectfully wish to point out that the date of first class mail deposit with the U.S. Postal Service was during the time of interruption of United States Postal Service delivery to the Patent and Trademark Office due to the events of 11 September 2001.²

Accordingly, Applicants respectfully request withdrawal of the holding of abandonment of the above-referenced application.

Applicants believe that no fee is due with the filing of this Petition. However, if there are any other fees due in connection with the filing of the Petition, please charge the fees to Deposit

² See Notices posted on the Patent and Trademark Office website (Exhibit F) at, *e.g.*, www.uspto.gov/September11/termsusp.html; www.uspto.gov/September11/expressmailtempaddress.htm; www.uspto.gov/September11/uspsmaildisrupt.htm; www.uspto.gov/September11/mitigationofmaildelays.htm; and www.uspto.gov/web/offices/pac/dapp/opla/preognotice/appsfiledups.htm

U.S. Serial No. 09/528,225

Account 08-0219. Also, please charge any fees underpaid or credit any fees overpaid to the same Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tamera M. Pertmer", written over a horizontal line.

Tamera M. Pertmer, Ph.D.

Agent for Applicant

Registration No. 47,856

Date: 18 Sept. 2002
HALE AND DORR LLP
1455 Pennsylvania Ave., NW
Washington, DC 20004
Tel: (202) 942-8332
Fax: (202) 942-8484